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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,612	05/13/2005	Venkateswarlu Jasti	03108/0202224-US0	9020

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DARBY & DARBY P.C.  
P.O. BOX 770  
Church Street Station  
New York, NY 10008-0770

EXAMINER
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SAEED, KAMAL A

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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06/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/518,612	<b>Applicant(s)</b> JASTI, VENKATESWARLU	
	<b>Examiner</b> Kamal A. Saeed	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 5-13 and 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 & 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/30/07</u> | 6) <input type="checkbox"/> Other: _____  |

### ***DETAILED ACTION***

Claims 1-22, are currently pending in the instant application. Claims 5-13 and 15-22 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

### **Information Disclosure Statement**

Applicant's Information Disclosure Statement, filed on April 30, 2007 has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

### **Response to Restriction**

Applicant's election with traverse of Group I, claims 1-4 and 14, drawn to compounds of structural formula I, as depicted in claim 1, and the specific compound, of Example 1, 11-(2-N,N-dimethylaminoethyl)isoindolo[indol-6-one, in response filed on 13 April 2007 is acknowledged. Applicant's arguments have been fully considered and were found partially persuasive with respect to the restriction requirement. Applicants argue that the restriction requirement does not establish that searching all the inventions would constitute an undue burden to the Patent Office. Applicants argue that Groups I- XIII are not independent and need to be examined together because they have a common core. The argument was found to be partially persuasive and the restrictions between the different groups of the compounds of claims 1-4 and 14 are hereby withdrawn. However, the restriction between the compounds, the method of use and the intermediate compound is maintained. In accordance with M.P.E.P. 821.04 and In re Ochiai, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims and method of use claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product

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claims and process is deemed proper. Even though an art rejection has not been made in this application, the requirement for restriction is maintained and the search has not been extended. It is pointed out that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) the claimed subject matter accordingly. Thus, the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. No where do Applicants argue to the contrary. No where do Applicants point out and give reasons why the claims do not involve independent or distinct subject matter. Accordingly, the restriction is proper. Moreover, it would constitute a burden to extend the search because separate search considerations would be involved in both the U.S. Patents and in the literature. The examination process following the search could easily result in different and thus burdensome considerations.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, page 5, line 2, and recite the term "contains" in reference to the compound. The term "contains" is open-ended in nature whereas a chemical compound must be claimed with precision compound line 33, is indefinite. It is suggested to delete the term "

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contains” and replace it with terms “have”. Claim 2 and 3 recite “N-oxide forms” in reference to compounds of Formula I. It is unclear what or how many nitrogen atoms are N-oxide forms.

Deleting the term “N-oxide forms” can obviate the rejection.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is independent and recites “A compound of general formula (I)”. The chemical structure of formula (I) is not provided in the claim. The formula is described in the specification and in claim 1. Claims must, under modern claim practice, stand alone to define an invention, and incorporation into claims by express reference to the specification is not permitted. *Ex parte Fressola*, 27 USPQ 2d 1608 (1993). Therefore, It is suggested that Applicants either provide the structure of Formula I, or make the claim depend on claim 1.

### **Closest Prior Art**

The closest prior art is U.S. Patent No. 5,206,382.

### **Telephone Inquiry**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed, Ph.D. phone number is (571) 272-0705. The examiner can normally be reached on M-T 7:00 AM- 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

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Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER